

Hearing:
April 6, 2004

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
July 8, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pramil S.R.L. (Esapharma)

v.

Mitchell Cosmetics SARL

Opposition No. 91122317
against Application Serial No. 75803862

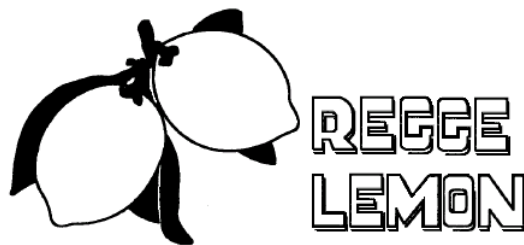
Donald L. Dennison of Dennison Schultz & Dougherty for
Pramil S.R.L. (Esapharma).

David M. Rogero for Mitchell Cosmetics SARL.

Before Simms, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Mitchell Cosmetics SARL (a corporation of Switzerland)
seeks registration on the Principal Register of the design
mark shown below:



for goods identified in the application as filed as follows:

"skin and body lotions, skin creams, skin gels, skin powders, skin masks; skin soap; perfume," in International Class 3; and

"medicated skin care preparations," in International Class 5.¹

Registration has been opposed by Pramil S.R.L. (Esapharma) (a corporation of Italy), alleging that opposer has continuously used the mark REGGE LEMON for a variety of cosmetic products and has exported such products to the United States since prior to any date which may be claimed by applicant; and that applicant's mark, when used in connection with both classes of identified goods, so resembles opposer's previously used trademark as to be likely to cause confusion, to cause mistake, or to deceive. Applicant has denied all the salient allegations of the notice of opposition.

Both parties have fully briefed the case and an oral hearing was conducted before the Board. Applicant chose not to make an appearance at the scheduled hearing.

¹ Application Serial No. 76803862 was filed on September 20, 1999 alleging a *bona fide* intention to use the mark in commerce in addition to claiming a basis for registration under Section 44(e) on the basis of a foreign registration of Switzerland. The word "LEMON" has been disclaimed apart from the mark as shown.

The record consists of the pleadings; the file of the opposed application; the testimony, with exhibits, of Jacob Aini and of Michael Aini, both officers of I.C.E., opposer's United States distributor.

Preliminarily, we note that applicant objects to a number of opposer's key exhibits on the basis that they were not produced during discovery. In moving to strike several key exhibits, applicant does not point to specific interrogatories or document requests. However, applicant's counsel did timely object to the introduction of each of these exhibits as reflected in the two trial transcripts of record. As to opposer's Exhibit 7 (an invoice documenting opposer's first shipment of REGGE LEMON gel into the United States), opposer offered the following explanation for its failure to make this available during discovery:

Q [Mr. Dennison]: Was there a time after we received the original Discovery Request that I asked you to make a search for records of your company to show the earliest inception?

A [Mr. Jacob Aini]: Yes.

Q: Did you send me a number of invoices?

A: Yes.

Q: Was this particular invoice [of April 20, 1997; Exhibit 7] in that original shipment that you sent to me?

A: Correct, it was. No, this was done later, this invoice. I don't know if it was the first one.

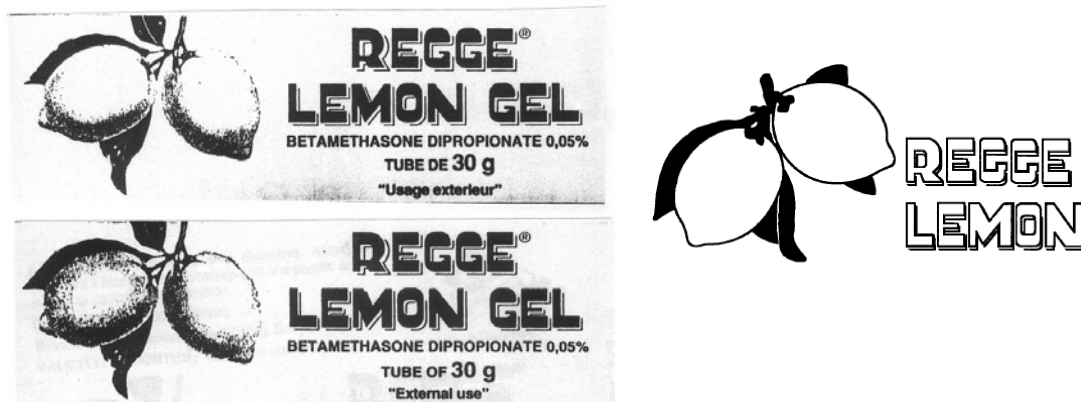
- Q: Can you tell me the situation with regard to the I.C.E. records within the last few years?
- A: Well, I.C.E. had a, what do you call it? A robbery, a burglary, and a lot of the papers got mixed up in the office, so the records are a little bit mixed up, because papers were thrown all over, but they are in the office of I.C.E.
- Q: So when I first asked you for a search of the materials, you did not produce this for me; is that correct?
- A: No, the first time, no. This was the second search.
- Q: When did you discover this particular document?
- A: Recently.
- Q: Within the last month or so?
- A: Probably less than that even.
- Q: In preparation for this deposition?
- A: Exactly, so I come with the facts and what have you on paper to testify.

Trial testimony deposition of Jacob Aini, pp. 29 - 31.

Opposer admits that several of its exhibits were not produced during discovery as requested. Arguably their appearance during the deposition of Jacob Aini resulted in some degree of surprise to applicant at trial. However, the record contains no copies of the discovery requests applicant argues would have covered these exhibits, and applicant's counsel who was present at the testimony deposition failed to cross-examine Mr. Aini about the circumstances of the burglary, how the objected-to documents were finally located prior to the witnesses' testimony, etc. Accordingly, we overrule applicant's

objection to various exhibits placed into the record by opposer and we have considered them in arriving at our decision herein.

We turn first to the issue of likelihood of confusion. There is no question but that there is a likelihood of confusion involved herein. In fact, the parties do not argue otherwise. The marks are identical, down to the stylization of the letters. The images below on the left are taken from two of opposer's packages while the image on the right is applicant's special form drawing herein²:



Furthermore, although the record contains no extensive discussion of the goods, applicant's goods are identified as "skin and body lotions, skin creams, skin gels, skin powders, skin masks, skin soap, perfume and medicated skin

² Q: How does that [trademark used by Michell Cosmetics] compare to the Pramyl trademark, in your opinion?

A: Exactly the same, complete knock off.
[J. Aini, p. 41].

care preparations" and opposer has established use of its mark on skin care gel and skin care cream. Thus, the goods are identical or closely related. Hence, this case turns on which party prevails on the dispute over priority.

Applicant took no testimony in this case and did not submit any other documentary evidence during applicant's testimony period. The earliest date on which applicant is entitled to rely is applicant's September 20, 1999 filing date of its application - its constructive use date.

Contrary to applicant's contention in its brief,³ applicant is not entitled to an earlier priority date based upon its Swiss application. Applicant made no such claim in the instant application and was not eligible for priority as its application in the United States was not filed within six months after the filing date of the foreign application. 15 U.S.C. §1126(d)(1); 37 C.F.R. §2.34(a)(4)(i).

In order to understand the chronology surrounding opposer's use of this mark, we rely primarily upon the testimony of Jacob Aini. According to Mr. Aini's

³ "Applicant seeks registration pursuant to 15 U.S.C. §1126(e), based upon a registration of the mark in Switzerland with an effective date of December 7, 1998." Applicant's brief, p. 4.

testimony, based on his interaction with Jamaican customers of his Homeboy's Discount store in 1983, he conceived of the idea of marketing a natural skin care product having a trademark reminiscent of reggae music (J. Aini, p. 14, Exhibit 2). In August 1984, he floated with potential vendors a "test program" of a "REGGE LEMON" product (J. Aini, pp. 14 - 15, Exhibit 3). Though still without a manufacturer or product more than ten years later, Mr. Aini paid \$90 in October 1994 for the design of artwork for a packaging label for "REGGE LEMON gel" (J. Aini, pp. 23 - 24, Exhibit 6). Then in late 1996, Mr. Aini traveled to Italy and met with Roberto Sottocorno, opposer's principal, to discuss a skin gel product bearing the name REGGE LEMON. Opposer is an Italian manufacturer of pharmaceutical products and cosmetics including skin care products. While the record does not disclose the nature of their understandings as to opposer's ownership of this mark, it seems Mr. Aini was pleased that his idea resulted in Mr. Sottocorno's adoption and use of this mark on skin gel. The first shipment of REGGE LEMON gel documented in this record was made from opposer to its U.S. distributor, I.C.E. International, via an invoice dated April 20, 1997 (J. Aini, pp. 27 - 29, Exhibit 7). This shipment involved

more than seventeen thousand tubes of gel at a cost to I.C.E. of almost seventy thousand dollars. The testimony and other evidence shows that these goods moved through various wholesalers (e.g., I.C.E., I.B.E. and Mr. King) (J. Aini, p. 37) to be sold at retail to the ultimate customers continuously up through the time that the record in this case closed, although the record shows no further shipments of REGGE LEMON gel from opposer in Italy into the United States prior to applicant's constructive use date of September 20, 1999.

We are convinced that the documents of April 1997 demonstrate the beginning of opposer's "use in commerce" with the United States of this mark. That is, combined with the subsequent sales at retail, this shows the *bona fide* use of a mark in the ordinary course of trade. 15 U.S.C. §1127. Accordingly, based on this entire record, we find that opposer has shown by a preponderance of the evidence that it has a priority of use in the United States.

Decision: The opposition is sustained on the ground of likelihood of confusion and registration to applicant is hereby refused as to both classes of goods.